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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Inner Vision Imaging, LLC

Serial No. 76384323

Julie A. Greenberg and Douglas W. Sprinkle of Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski, P.C. for Inner Vision Imaging, LLC.

Linda M. Estrada, Trademark Examining Attorney,¹ Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Hohein and Chapman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Inner Vision Imaging, LLC has filed an application to register on the Principal Register the mark "MICROLAPAROSCOPE" for "surgical instruments, namely laparoscopes."²

¹ Such attorney submitted the brief on behalf of the Office; prior thereto, examination of the application was conducted by Trademark Examining Attorney Karen K. Bush of Law Office 105.

² Ser. No. 76384323, filed on March 13, 2002, which is based on an allegation of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "MICROLAP," which is registered for "medical instruments, namely endoscopes, laparoscopes [sic], introducers, graspers, blunt probe instruments, and couplers,"³ as to be likely to cause confusion, or to cause mistake, or to deceive.⁴

Applicant has appealed. Briefs have been filed, but an oral hearing was not held.⁵ We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or

³ Reg. No. 1,997,090, issued on August 27, 1996, which sets forth a date of first of the mark anywhere and in commerce of August 30, 1994; combined affidavit §§8 and 15 accepted and acknowledged, respectively.

⁴ Although registration was also finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark is merely descriptive of its goods, such refusal was withdrawn in response to applicant's subsequent request for reconsideration, but the final refusal on the remaining ground of likelihood of confusion was adhered to.

⁵ While applicant submitted a request for an oral hearing, it subsequently filed a withdrawal of such request.

dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.⁶

Turning first to the similarity or dissimilarity in the goods at issue, it is plain that registrant's goods are identical in relevant part to applicant's goods inasmuch as registrant's goods include laparoscopes. Although applicant argues in its main brief that its laparoscopes and those of registrant are "quite different" because applicant's product is a "unique, patented instrument for taking micro-samples," while registrant's product is instead a "micro-sized laparoscope," it is well settled, as the Examining Attorney correctly points out in her brief, that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and the cited registration, and not in light of what such goods are asserted to actually be. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Because neither the identification of applicant's goods nor that of registrant's goods contains any restriction as to the

⁶ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

channels of trade for the respective goods or any limitation as to their classes of purchasers, it is presumed in each instance that in scope both applicant's application and the cited registration encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for those goods, and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Accordingly, applicant's and registrant's laparoscopes must be considered to be legally identical goods for present purposes, notwithstanding applicant's contention that while such goods "may both be medical, they are completely different in nature." Plainly, if legally identical laparoscopes were to be sold under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur.

Turning, therefore, to consideration of the similarity or dissimilarity of the respective marks in their entireties, we start with the proposition that, "[w]hen marks would appear on virtually identical goods, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994). Applicant argues, however, in its main brief that its mark is not likely to cause confusion with registrant's mark, even when both are used in connection with laparoscopes, because "the marks are actually different in

meaning and appearance." In particular, and in view of the definition of record from The American Heritage Dictionary of the English Language, (3d ed. 1992), which defines "micro" in relevant part as meaning "small," applicant contends that registrant's mark is weak and thus merits only a limited scope of protection:

It should be noted ... that the cited mark is ... a highly descriptive mark and entitled to only a narrow zone of protection. This is because the mark, MICROLAP, is used on small laparoscopes, or microlaparoscopes. In other words, because it is essentially a combination of the basic elements "micro" and "lap," short for "laparoscope, to indicate a small laparoscope, the cited mark is extremely weak, and entitled to only a narrow range of protection.

As ... held in *Sure-Fit Products Co. v. Saltzson Drapery Co.*, ... [254 F.2d 158, 117 USPQ 295 (CCPA 1958),] "[w]here a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights." Because the cited mark here, MICROLAP, is nothing more than a shortened word for the generic word used to describe the underlying goods, MICROLAPAROSCOPE, it is unquestionably descriptive and weak, and provides third parties with the opportunity to use marks closely similar to it without creating a likelihood of confusion.

Contending further that its mark is similar to registrant's mark "only to the extent" that it "incorporates the term 'micro' or 'lap,'" applicant additionally argues that (*italics in original*):

In concluding that MICROLAPAROSCOPE is confusingly similar to the cited mark MICROLAP, the Examiner has disregarded the important distinguishing feature that Applicant's mark is not a shortened form of a word; rather, Applicant's mark is an inventive play on the component "micro" to

indicate that the instrument obtains and analyzes "micro" size samples, not that the overall instrument is a "micro size."

In focusing only on the common elements of the respective marks, and not factoring in the differences, including ... their appearances and meanings, the Examiner has improperly focused only on the common elements of the marks, and has disregarded their differences. This narrow focus only on the similarities, and the disregard of the differences, directly violates the Federal Circuit's anti-dissection edict set forth in *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992), which stresses the importance of making the comparison between marks *in their entireties*. Under *Hearst*, disregarding even merely descriptive elements of marks is inappropriate.

Here, applicant asserts, the "additional component" of its mark which is provided by the "-AROSCOPE" portion "contributes significantly to the commercial impression of Applicant's mark, and must be considered in the analysis for confusing similarity." When so considered in its entirety, applicant maintains, its mark is not likely to cause confusion with registrant's "MICROLAP" mark.

While the Examining Attorney attempts to counter applicant's contention that registrant's mark "is highly descriptive and weak" by asserting in her brief that "applicant has failed to support this allegation with evidence," the reason why such contention by applicant is impermissible, and thus cannot be entertained with respect to the issue of likelihood of confusion herein, is that it constitutes a collateral attack on the validity of the cited registration, which issued on the Principal Register. See, e.g., *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 at n. 7 (TTAB 1992); and *In re C. F. Hathaway Co.*, 190

USPQ 343, 345 (TTAB 1976). Registrant's "MICROLAP" mark, therefore, must at the very least be considered highly suggestive, rather than merely descriptive, of its laparoscopes, notwithstanding applicant's insistence that such mark "is nothing more than a shortened word for the generic word used to describe the underlying goods, MICROLAPAROSCOPE." Similarly, despite applicant's having essentially admitted that its "MICROLAPAROSCOPE" mark is a generic term for laparoscopes which are small in size relative to other laparoscopes, such mark for present purposes must at a minimum be considered, in view of the withdrawal of the refusal on the ground of mere descriptiveness, as no more than highly suggestive of such goods.

Nonetheless, even when considered as highly suggestive marks, we agree with the Examining Attorney that the contemporaneous use thereof in connection with laparoscopes would be likely to cause confusion as to the source or sponsorship thereof. Plainly, but for the addition of the ending "-AROSCOPE" in applicant's mark, the marks at issue herein are otherwise identical in sound and appearance given that, as noted by the Examining Attorney, "[b]oth marks feature the wording MICRO followed by the term LAP." Moreover, such marks are the same in connotation since, as applicant concedes, registrant's mark suggests or connotes a small laparoscope. Thus, as pointed out by the Examining Attorney, when considered in their entirety, the overall commercial impression of the respective marks is identical in that:

The conclusion reached by the Examining Attorney is the same as that which is

proposed by the applicant, namely, that the registered mark is comprised of the terms "micro" and "lap," which is short for microlaparoscope. Similarly, the proposed mark is comprised of the terms "micro" and "laparoscope[,]" yielding MICROLAPAROSCOPE.

We accordingly conclude that customers who are familiar or acquainted with registrant's "MICROLAP" mark for its laparoscopes would be likely to believe, upon encountering applicant's substantially identical mark "MICROLAPAROSCOPE" for legally identical goods, namely, laparoscopes, that such products emanate from, or are sponsored by or affiliated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.